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Reply to Office Action of 11/14/2006

REMARKS/ARGUMENTS

Claims 1–102 are pending in the above-captioned application. Claims 1–74 are withdrawn from consideration, and claims 75–102 stand rejected. With this paper, claims 1–74 and 76 have been canceled, and claims 75, 82, 96, and 97 have been amended. No new matter was added with the amendment.

I. Election/Restrictions

Applicants have elected without traverse to prosecute the invention of Group I. To simplify prosecution of this case, Applicants are canceling claims 1–74, while retaining the right to pursue those claims in a divisional application. Cancellation of the non-elected claims does not necessitate an amendment to the inventorship.

II. Claim rejection under 35 U.S.C. § 112, second paragraph

Claim 97 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. Applicants have amended claim 97 to eliminate the word “transferring,” which the Examiner found to be indefinite. With this amendment, Applicants respectfully assert that claim 97 should be found to comply with the requirements of 35 U.S.C. § 112, second paragraph.

III. Claim rejections under 35 U.S.C. § 103(a) as being unpatentable over Wolk et al. (US 6,620,625) in view of Ezrielev et al. (US 5,476,792)

Claims 75–78 and 82–98 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Wolk et al. (US 6,620,625) in view of Ezrielev et al. (US 5,476,792). The rejection of these claims is respectfully traversed.

To warrant rejection under 35 U.S.C. § 103(a), all the claim limitations must be taught or suggested by the prior art. See MPEP § 2142. With regard to currently amended independent claims 75 and 82, at a minimum, neither Wolk et al. nor Ezrielev et al. teach one or more alignment marks disposed at a distance from a reagent array. This limitation of the invention has been added to claims 75 and 82 to more particularly point out and distinctly claim

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Applicants' invention. Support for the limitation can be found in Figures 2A and 2B, which show alignment marks at 11 and reagent spots at 9 and 10, the reagent spots arranged in an array in each of Figures 2A and 2B. Alignment marks 11 are clearly disposed at a distance from the arrays shown in Figures 2A and 2B. Thus, no new matter has been added by amending the claims to include this limitation. Applicants wish to point out that they have also amended independent claim 75 to include the limitations of original claim 76, which has been canceled. All other amendments to claims 75 and 82 improve clarity or consistency and add no new matter.

Wolk et al. teach "a fabricated alignment mark" in column 21, line 1; however, the alignment mark of Wolk et al. is not at a distance from the array. Instead, the alignment mark is "on the array, e.g., a mark in the array or on its upper or lower surface that corresponds to the location of the first spot." See column 21, lines 2 and 3. The "first spot" is a spot within the array. This is made clear in column 20, lines 24-29, 37-42, and 60-63 of Wolk et al. The reagent materials are spotted in an array having one or more rows of compounds in a grid format. The system is aligned by locating outer spots in the grid (e.g., the four corner-most spots on the array). "In operation, the system moves the sampling element to a position that is close to the expected position of one of the corner spots (the 'first position'). The sampling element is then aligned to the first spot...."

Ezrielev et al. are similarly silent with regard to one or more alignment marks disposed at a distance from a reagent array. Thus, the combination of the Wolk et al. and Ezrielev et al. references neither teaches nor suggests all of the limitations of Applicants' amended independent claims 75 and 82. Therefore, withdrawal of the rejection of these claims as being unpatentable over Wolk et al. in view of Ezrielev et al. is respectfully requested.

Claim 96 has been amended to be an independent claim that includes all of the limitations of claim 82, from which it originally depended. Therefore, claim 96 is allowable for the same reasons presented above with regard to claim 82. Applicants wish to point out that the preamble of claim 96 has been changed to a "method of fabricating and using an alignment marked chip." The restriction requirement mailed October 26, 2006, restricted the original claims into three groups. All of the claims in Group III, which is the group being currently prosecuted, are restricted to "an alignment marked substrate and method of making." The currently amended claim 96 still falls within this group.

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Claims 77 and 78 depend directly from amended independent claim 75, claims 83–95 depend either directly or indirectly from amended independent claim 82, and claims 97 and 98 depend directly from amended independent claim 96. Any claim depending from a nonobvious claim is also nonobvious. See MPEP § 2143.03 and *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent claims 77, 78, 83–95, 97, and 98, are nonobvious. Withdrawal of the rejections of these claims as being unpatentable over Wolk et al. in view of Ezrielev et al. is, therefore, respectfully requested. As previously discussed, claim 76 has been canceled.

IV. Claim rejections under 35 U.S.C. § 103(a) as being unpatentable over Wolk et al. (US 6,620,625) in view of Ezrielev et al. (US 5,476,792) and further in view of Wagner et al. (US 6,475,809)

Claims 79–81 and 99–102 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Wolk et al. (US 6,620,625) in view of Ezrielev et al. (US 5,476,792), as previously applied to claims 75–78 and 82–98, and further in view of Wagner et al. (US 6,475,809). The rejection of these claims is respectfully traversed.

As demonstrated above, Applicants' amended independent claims 75 and 96 are nonobvious over Wolk et al. in view of Ezrielev et al. Wagner et al. does not provide the limitation shown above to be missing from both Wolk et al. and Ezrielev et al.: one or more alignment marks disposed at a distance from a reagent array. Therefore, amended independent claims 75 and 96 are nonobvious over the combination of Wolk et al., Ezrielev et al., and Wagner et al. Claims 79–81 depend either directly or indirectly from amended independent claim 75, while claims 99–102 depend either directly or indirectly from amended independent claim 96. As any claim depending from a nonobvious claim is also nonobvious, dependent claims 79–81 and 99–102 are nonobvious. Withdrawal of the rejection of these claims as being unpatentable over Wolk et al. in view of Ezrielev et al. and further in view of Wagner et al. is, therefore, respectfully requested.

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Conclusion

For the foregoing reasons, Applicants believe all the pending claims are in condition for allowance and should be passed to issue. If the Examiner believes that a telephone interview would expedite the examination of this application, the Examiner is requested to contact the undersigned attorney at the telephone number provided below.

Respectfully submitted,



Ann C. Petersen
Reg. No. 55,536

CALIPER LIFE SCIENCES, INC.
605 Fairchild Drive
Mountain View, CA 94043
Direct: 650-623-0667
Fax: 650-623-0504
ann.petersen@caliperLS.com

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Signed: _____

